

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks. The Office Action indicates that it is a Final Office Action. Applicants submit that it is inappropriate for the examiner to enter a Final Office Action in view of the request for continued examination (“RCE”) filed with the previous response. Accordingly, applicants request withdrawal of the Final Office Action.

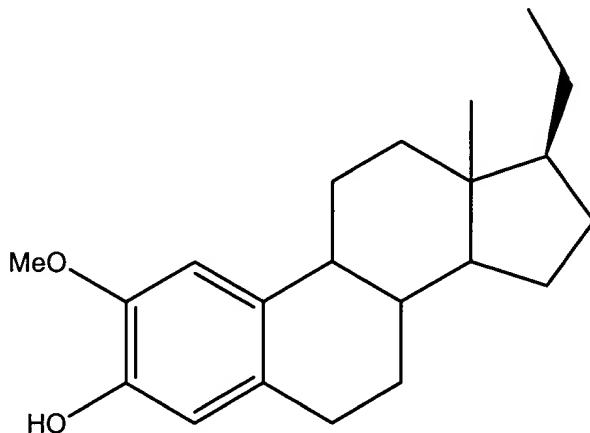
Claims 94 and 96 are presently pending in this application. Applicants are amending herewith Claim 94. Following entry of these amendments, Claims 94 and 96 will be pending. In view of the inappropriateness of the Final Office Action, applicants submit that entry of these amendments is appropriate and that Claims 94 and 96 are entitled to further examination.

The Office Action

Claims 94 and 96 were rejected under 35 U.S.C. § 102(b) as being anticipated by the patent to Tanabe et al. (U.S. Patent No. 6,046,186). Claims 94 and 96 were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over the patent to Ram et al. (U.S. Patent No. 6,136,992). Claims 94 and 96 were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over the article by Cushman et al. Applicants are amending the claims herewith to overcome the foregoing rejections.

The Rejections Under Section 102

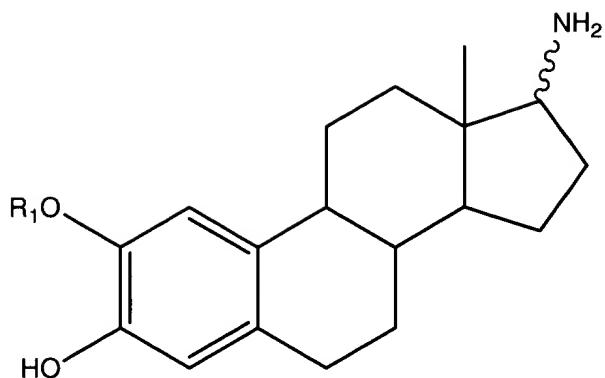
Claims 94 and 96 were rejected under 35 U.S.C. § 102(b) as being anticipated by the patent to Tanabe et al. The rejection references Compound No. 70 at col. 49 of Tanabe et al. Compound No. 70 has the following structure:



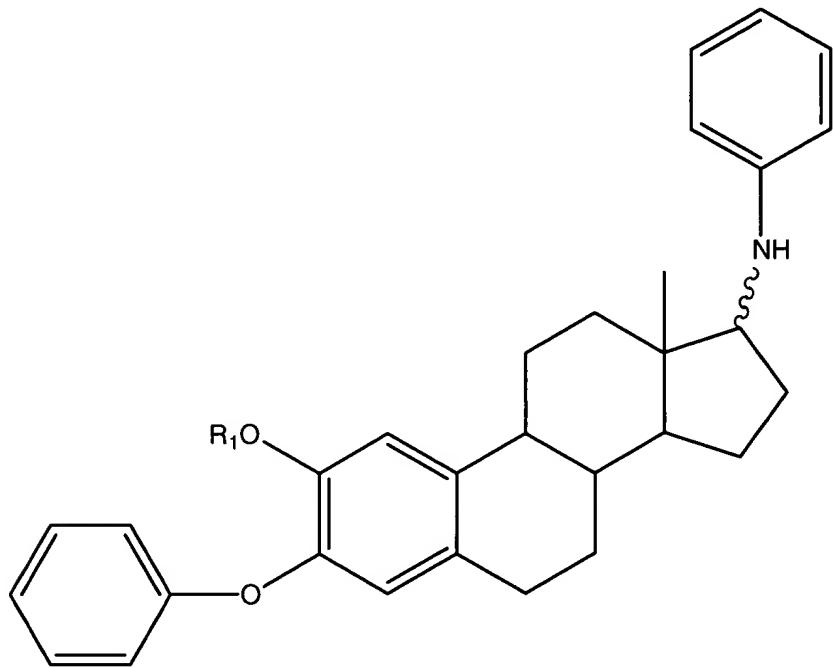
Applicants are amending herewith Claim 94 to remove $-\text{CH}_3$, $-\text{CH}_2\text{CH}_3$ and $-\text{CH}_2\text{CH}_2\text{CH}_3$ from the possible substitutents for Rg. Applicants submit that this amendment overcomes the present rejection based on Compound 70 of Tanabe et al. In view of the foregoing, applicants respectfully submit that the rejection of Claims 94 and 96 under 35 U.S.C. § 102(b) should be withdrawn.

The Rejections Under Section 103

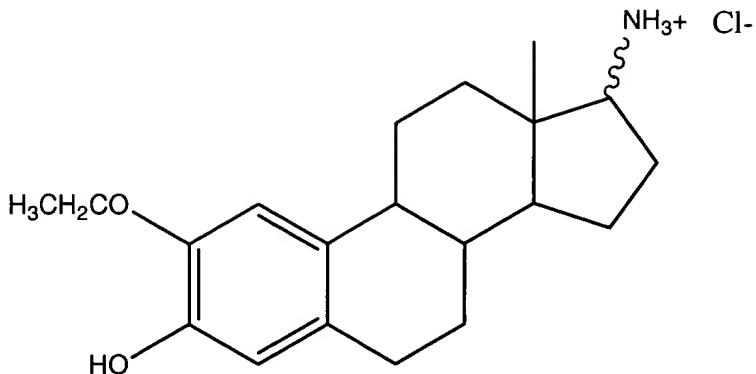
Claims 94 and 96 were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over the patent to Ram et al. (U.S. Patent No. 6,136,992). The rejection states that the prior art teaches 2-alkoxy estradiols which allegedly embraces the claimed invention. The Office Action also refers to Formula VI in Col. 7 of wherein R₁ represents a lower alkyl. Formula VI has the structure where R₁ is lower alkyl:



The Office Action also refers to Formula IX in col. 7 where R_{10} represents H or an amine-protecting group. Formula IX has the structure where the amine protecting group is a phenolic group, preferably benzyl or substituted benzyl:



The Office Action further references Compound 20 in Fig. 3 of Ram et al. Compound 20 has the structure shown below:

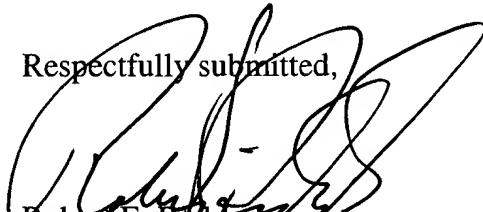


Applicants are amending herewith Claim 94 to remove the amino group. Applicants submit that this amendment overcomes the present rejection based on the referenced compounds disclosed in Ram et al. In view of the foregoing, applicants respectfully submit that the rejection of Claims 94 and 96 under 35 U.S.C. § 103 in view of Ram et al. should be withdrawn.

Claims 94 and 96 were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over the article by Cushman et al. The rejection states that the reference discloses estradiol derivatives of 2-ethoxy estradiol with modification at the 17-position with an amino group. Applicants consider Cushman et al. to be cumulative to Ram et al. Cushman et al. does not teach any compounds closer to the present invention than Ram et al. Accordingly, Claims 94 and 96, as amended, distinguish over Cushman et al. for the same reasons that they distinguish over the patent to Ram et al. In view of the foregoing, applicants respectfully submit that the rejection of Claims 94 and 96 under 35 U.S.C. § 103 in view of Cushman et al. should be withdrawn.

Conclusion

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and remarks. Applicants submit that all claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. Applicants further request that the Examiner call the undersigned counsel if allowance of the claims can be facilitated by examiner's amendment, telephone interview or otherwise.

Respectfully submitted,

Robert E. Richards
Reg. No. 29,105

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309-4530
Tel: (404) 815-6500
Fax: (404) 815-6555
Our Docket: 05213-0852 (43170-263550)